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| 10/675,287 | 09/30/2003 | Jeyhan Karaoguz | 14794US02 | 5434 |
| 7590 Christopher C Winslade McAndrews Held & Malloy Ltd 500 Wes Madison St 34th Floor Chicago, IL 60661 | | | EXAMINER RYAN, PATRICK A | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,287

Applicant(s)

KARAOGUZ ET AL.

Examiner

PATRICK A. RYAN

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is made in reply to Response Under 37 C.F.R. 1.111 ("Reply"), filed January 19, 2009. Applicant has amended Claims 1, 5-11, 15-21, 25-30; no claims have been added; and no claims have been canceled. As amended, Claims 1-31 are presented for examination.

2. In Office Action of October 17, 2008 ("Office Action"):

Claims 1-5, 8-15, 18-25, and 28-31 were rejected under 35 U.S.C. 102(e) as being anticipated by Novak (US PG PUB 2002/0104099 A1).

Claims 6, 7, 16, 17, 26, and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (US Patent Application Publication 2002/0104099) in view of Martin et al (US Patent 7,174,512).

Response to Arguments

3. Applicant's arguments, see Reply Section I.A Pages 11-12, with respect to the Examiner's statement of structural and functional equivalency regarding the Set-top Box 152 and Upload Source 122 of Novak because no support for this statement is found within the teachings of Novak have been fully considered and are persuasive (presented in Office Action Page 4). Therefore, this statement has been withdrawn. The Examiner notes however that Novak explicitly discloses that Upload Source 122 can comprise or use a set-top box (with reference to Paragraphs [0039,0056]), however

the Examiner acknowledges that Novak does not provide evidence that the set-top box used by Upload Source 122 functions in the same manner as STB 152.

4. Applicant's arguments, see Reply Pages 13-20, have been fully considered but they are not persuasive.

5. Applicant presents that Novak does not teach "organizing, at said first location, said located media and at least a portion of television broadcast media into channels" because "server 124 (and not the uploader 122) stores the media for the synthetic channel" and that "[t]he synthetic channel is organized at the location of server 124, not the uploader 122" (Reply Pages 13 and 17). In addition, Applicant points out that "none of the data that is uploaded by the upload source 122 to the server or web site 124 includes any broadcast programming" (Reply Pages 15 and 17). The Examiner respectfully disagrees.

The Examiner first address Applicant's statement that "an 'uploading individual' is not a 'geographic location'" (Reply Pages 13 and 17 in response to Office Action Page 4). The Examiner is addressing Applicant's claimed "first location" using an "uploading individual at Upload Source 122." Novak discloses that media objects "are uploaded to the web site 124 by the upload source 122 (i.e. an individual or consumer)" (Novak Paragraph [0056]). Novak also describes operational steps in terms of "the individual" such as "at block 404, the individual can use an application to create a schedule of programming for the synthetic channel that is to play the media objects" (as disclosed in Paragraph [0057]). It is the Examiner's position that Novak's disclosure of "the

individual" is referring to operations performed at the location of Upload Source 122 and for this reason has stated "uploading individual at Upload Source 122" to clarify the Examiner's interpretation of the teachings of Novak. The Examiner does not contend that an "uploading individual" is a "geographic location", however it is the Examiner's position that Upload Source 122 represents a geographic location within the system of Novak (as shown for example in Fig. 1).

Regarding the "organizing... said located media..." limitation of Claim 1, the Examiner submits that Novak teaches locally stored media being organized at Upload Source 122 prior to uploading this content to Web Site 124 by way of Figure 7. As the Examiner has previously presented (Office Action Pages 4-5):

In addition, regarding Applicant's interpretation of Fig. 4, the Examiner presents that at Block 404 "the [upload] individual can use an application to create a schedule of programming for the synthetic channel this is to play the media objects" and that "a web-based application may be used by the individual to create the program schedule from the web site 124. It is to be appreciated that other types of tools or applications may be used in addition to or instead of a web-based application." (Novak Paragraph [0056 and 0057]). Novak also teaches in Paragraph [0063] that this "application" is implemented by way of User Interface 702 of Fig. 7, which "can be used with a PC or with set top box 504 to organize various media objects into one or more media programs for a synthetic channel."

In particular, as shown in Fig. 7 of Novak, media within Joe's TV Channel is organized by date and time slot (elements 704, 706, and 708; Paragraphs [0063-0066]) and once the media is organized into a channel (shown as element 710), the individual can then send/save the settings to the Web Server 124 using the "upload/update" Button 712 (Paragraph [0067]). Therefore, it is the Examiner's position that the interface of Fig. 7 demonstrates the media is first organized by date and time to form a sequence of programming, which is the personal media channel, and then the media channel is uploaded by the individual using Button 712.

Regarding the "organizing... at least a portion of television broadcast media..." limitation of Claim 1, the Examiner submits that Applicant has not provided sufficient evidence to support the argument that the organization of "television broadcast media" (in a "mass-communicated" broadcast sense) can be performed at the first geographic location (as originally presented in Office Action Page 7). Both the Applicant and the Examiner have identified Paragraph [47] of the instant application as evidence of support of "organizing... television broadcast media". However, the Examiner notes (as previously presented in Office Action Page 7 regarding Paragraph [47] of the instant application):

In view of Applicant's disclosure, it is the Examiner's position that "broadcast media" and "locally stored" media are presented in a "coexist[ing]" fashion at Applicant's "second location", where "the broadcast media may be distributed from a broadcast television station", which is in accordance with the teachings of Novak, as discussed above.

The Examiner emphasizes that this passage is directed toward the presentation of media at Applicant's claimed "second location" and not the "first location". Furthermore, it is the Examiner's position that Paragraph [47] of the instant application demonstrates that a "broadcast television station" and/or a "cable provider" organizes and distributes the "broadcast media". It is unclear to the Examiner how an individual is to "organize" broadcast media content (such as an ABC News broadcast, in a "mass-communicated" sense) into a program channel and then transfer this channel to a second user. In view of Applicant's further limiting of "broadcast media" to "television broadcast media", the Examiner will address this limitation below as best understood by one of ordinary skill in the art.

6. Applicant also presents that Novak does not teach "transparently transferring from said first location, at least a portion of said organized channels to at least a second location within the communication network" because "at step 406, a token or electronic file is sent to the end user to subscribe the end user's terminal (set top box 152) to the synthetic channel". Applicant cites Novak Paragraph [0058] "discloses that the individual (who uploads the media to server or web site 124) emails the token or other electronic file to the end user" and states that "Obviously, the user will be aware of such emailed token" (Reply Pages 19-20). The Examiner respectfully disagrees.

The Examiner first notes the Applicant has not provided evidence to support a statment of obviousness regarding the a user being aware of an emailed token. Applicant also presents (Reply Page 14) the following in response to the Examiner's interpretation (Office Action Page 7) of Paragraph [68] of the instant application:

Applicant respectfully disagrees and points out that even if "Mom" gives an authorization to "Brother" to perform transparent media transfers, this does not mean that "Mom" will be aware exactly when the act of transparent media transferring will take place.

The Examiner originally cited Paragraph [68], particularly the last sentence, in response to Applicant's argument of "being aware of an emailed token" (as taught by Novak). In response to Applicant's argument, the Examiner submits that a user receiving an email would be equally unaware of "exactly when the act" of sending the email would be performed by the composing user. Additionally, the Examiner has also cited Novak's teachings of a Java applet that is automatically downloaded and triggers an update of EPG 153 (as described in Paragraph [0080]) to address the claimed "transparently transferring" limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **1-5, 8-15, 18-25, and 28-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Novak (US Patent Application Publication 2002/0104099)** in view of **Wood et al. (US Patent Application Publication 2002/0054752 A1)** hereinafter "Wood".

With respect to Claim **1**, the claimed "*locating media stored locally at least at a first geographic location in the communication network; organizing, at said first geographic location, said located media into channels*" is met by the Novak reference that teaches an uploading individual at upload source 122 organizing media by way of User Interface 702 of Fig. 7 for presentation within EPG 153 of Fig. 9, which is viewable by way of a set top box device (*Figs.1, 4, 7, 9, and 11; paragraphs 0010, 0026, 0039, 0041, 0056-0060, 0063, and 0078-0086*).

The claimed "*transparently transferring from said first geographic location, at least a portion of said organized channels to at least a second geographic location within the communication network*" is met by the Novak reference that teaches client terminal of end user at STB 152 receiving media files associated with the 'synthetic' channel when it is selected for viewing- whereby a 'synthetic' channel is added to an user's EPG 153

at a 2nd location, via an emailed token or other electronic file, such as a Java applet that is automatically downloaded and triggers an update of EPG 153 (*Figs. 1,2,4,9,11; paragraphs 0041, 0058, 0059, 0080, 0085, & 0086*).

However, Novak does not explicitly disclose organizing at least a portion of television broadcast media into channels.

In a similar field of invention, Wood teaches a method and apparatus for allowing a user to control recoding and storage of television signals into personal channels (Abstract). Wood further discloses that storage of shows may be organized into personal channels in order to facilitate later playback (Abstract, Paragraphs [0058-0061]; with further reference to the interface of Fig. 10).

Both Novak and Wood demonstrate similar techniques for organizing locally stored media content into personal program channels. Novak discloses the organization of local media by way of Joe's TV Channel using the interface of Figure 7 and Wood discloses the organization of television broadcast media by way of personal channels such as that of Fig. 10. One of ordinary skill in the art at the time of the invention would have recognized that the similar techniques of Novak and Wood are usable together because each demonstrates the organization of locally stored media to be presented within an electronic program guide. One of ordinary skill would have been motivated to provide an individual the ability to organize television broadcast media and local media within the same channel guide so that a user has the ability to consolidate a variety of media programs into a single user interface.

With respect to Claim 2, the claimed *"displaying said organized channels in at least one constructed display"* is met by Novak teaching the use of a display 154 at a second location 152 for displaying a synthetic channel 804 listed on an EPG 802 (Figs. 1 & 8; paragraphs 0026 & 0071).

With respect to Claim 3, the claimed *"constructed display is at least one of a media guide, device guide and a channel guide"* is met by Novak teaching the use of an EPG 802 in displaying a 'synthetic' channel listing (Fig. 8; paragraph 0071).

With respect to Claim 4, the claimed *"constructed display is formatted as a graphical user interface"* is met by Novak teaching an EPG 802 that is configured to access media displayed in a 'synthetic' channel listing once it has been selected (Fig. 8; paragraph 0072).

With respect to Claim 5, the claimed *"constructed display is displayed at one or both of said first geographic location and/or said geographic second location"* is met by Novak that teaches the use of a display 154 at a second location 152 (Fig. 1; paragraph 0038).

With respect to Claim 8, the claimed *"transparently transferring media corresponding to at least said second geographic location"* is met by Novak teaching media being sent to a 2nd location 152 once a 'synthetic' channel is selected on the EPG 153 (Fig. 1; paragraphs 0058, 0059, 0080, & 0085).

With respect to Claim 9, the claimed *"updating an existing constructed display at said second geographic location to reflect said transparently transferred at least a*

portion of said organized channels" is met by Novak teaching an EPG 153 being updated with media programs on a 'synthetic' channel created by an uploading source 122 (Fig.1; paragraphs 0041, 0058, 0059, 0080, & 0083).

With respect to Claim 10, the claimed "*authorizing said transparent transfer of said at least a portion of said organized channels to at least said second geographic location*" is met by Novak teaching the use of a 'token' to subscribe a user at 2nd location 152 in order for the receipt of 'synthetic' channel listing and ultimately allowing the transfer of media to the 2nd location or by a user at a 2nd location navigating to a website where a piece of software can be downloaded and an update of EPG 153 can be triggered (Figs. 4, 11, paragraphs 0058 & 0080).

Claim 11 is met as previously discussed with respect to Claim 1.

Claim 12 is met as previously discussed with respect to Claim 2.

Claim 13 is met as previously discussed with respect to Claim 3.

Claim 14 is met as previously discussed with respect to Claim 4.

Claim 15 is met as previously discussed with respect to Claim 5.

Claim 18 is met as previously discussed with respect to Claim 8.

Claim 19 is met as previously discussed with respect to Claim 9.

Claim 20 is met as previously discussed with respect to Claim 10.

Claim 21 is met as previously discussed with respect to Claim 1. In addition, Novak teaches that the upload source 122 can consist of a set top box or a PC uploading media files to a server (*Fig.1; paragraph 0055 & 0056*).

Claim 22 is met as previously discussed with respect to Claim 2.

Claim 23 is met as previously discussed with respect to Claim 3.

Claim 24 is met as previously discussed with respect to Claim 4.

Claim 25 is met as previously discussed with respect to Claim 5.

Claim 28 is met as previously discussed with respect to Claim 8.

Claim 29 is met as previously discussed with respect to Claim 9.

Claim 30 is met as previously discussed with respect to Claim 10.

With respect to Claim 31, the claimed "at least one processor is at least one of a media processing system processor, a media management system processor, a computer processor, a media exchange software processor and a media peripheral processor" is met Novak teaching an upload source 122 being a set top box or a PC (*Figs.1 & 2; paragraph 0039*).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims **6, 7, 16, 17, 26, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Novak and Wood in further view of **Martin et al (US Patent 7,174,512)**.

With respect to Claim **6**, the claimed *“presenting representations of locally stored media at said second geographic location and representations of said transparently transferred media in a single constructed display”* is met in part by Novak teaching a system that allows an individual to upload media files through a server to an end user, allows scheduling the order in which they are presented to a 2nd user in a ‘synthetic’ channel listing included in an EPG, and transferring the media files listed in the ‘synthetic’ channel listing upon its selection by the 2nd location as discussed in Claim **5** above.

However, Novak does not teach that the locally stored media at the 2nd location is represented in addition to the ‘transparently transferred media’. Martin et al. teaches a system that displays broadcast channels and locally or remotely stored content on one common display (*Fig.5c; col.1, lines 56-59; col.14, lines 22-25 & lines 44-47*).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate the teaching of Martin et al. with those of Novak, because both Martin et al. and Novak teach displaying available media content to an end user. A person with ordinary skill in the art would have been motivated to make the modification to Novak in order to allow the additional benefit of displaying local media available for viewing by a user of the system, thereby notifying them of all the media content that is available to them.

With respect to Claim 7, the claimed "*integrating representations of said television broadcast media in said presented single constructed display*" is met by Novak teaching a EPG 153 that contains both a 'synthetic' channel listing 908 created by a 1st user 122 and broadcast channel listings 902, containing local and national television channels (*Fig. 9; paragraph 0074*).

Claim 16 is met as previously discussed with respect to Claim 6.

Claim 17 is met as previously discussed with respect to Claim 7.

Claim 26 is met as previously discussed with respect to Claim 6. In addition, both Novak and Martin et al. teach the use of set top boxes in the displaying of available media. Specifically, Novak discloses set top box 152 (*Fig. 1*) and Martin et al. discloses set top box 1140 (*Fig. 2 & 4B*).

Claim 27 is met as previously discussed with respect to Claim 7.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./
Examiner, Art Unit 2427
Monday, May 04, 2009

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427